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In re Application of SHUSTER et al :
U.S. Application No.: 10/568,200 :
PCT Application No.: PCT/US2004/026345 : DECISION
Int. Filing Date: 13 August 2004 :
Priority Date Claimed: 14 August 2003 :
Attorney Docket No.: 25791.301.06 :
For: EXPANDABLE TUBULAR :
:

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 28 August 2007.

BACKGROUND

On 13 August 2004, applicant filed international application PCT/US2004/026345, which claimed priority of an earlier United States application filed 14 August 2003. The thirty-month period for paying the basic national fee in the United States expired on 14 February 2006.

On 13 February 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and a substitute specification.

On 12 September 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that a properly executed oath or declaration must be filed.

On 05 April 2007, applicant filed an executed declaration.

On 16 April 2007, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 28 August 2007, applicant filed the present petition under 37 CFR 1.182.

DISCUSSION

A review of international application PCT/US2004/026345 reveals that the application contained 848 claims. A proper amendment reducing the number of claims was never submitted in the international application.

MPEP 1893.01(c) states in relevant part,

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that cancels claims and/or eliminates multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492**>(d)-(e)< and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492*>(f)<. A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608. (Emphasis added.)

In the present case, the initial national stage submission on 13 February 2006 did not include a proper preliminary amendment. However, it is apparent from the papers filed 13 February 2006 that applicant sought to reduce the number of claims for examination at the time of national stage entry. Specifically, the substitute specification contained a listing of 39 claims, rather than the 848 claims contained in the international application. Furthermore, the transmittal letter (Form PTO-1390) contained a payment calculation based on the presence of 39 claims as opposed to 848 claims. A proper preliminary amendment was filed with the present petition, reducing the total number of claims to 39. Because of applicant's intent to reduce the number of claims for examination and because the fees due for the presence of 848 claims at the time of the initial national stage submission would not be remotely commensurate with number of claims that remain for examination, justice in the present case requires waiver of the requirement that a preliminary amendment must accompany the initial national stage papers in order to reduce the number of claims to be considered in calculating extra claim fees.

The petition states that \$9,005.00 has been paid for excess claim fees and requests a refund of \$855.00. However, a review of the fee records for the present application reveals that \$8,150.00 has been paid for excess claims fees. Therefore, a refund is not indicated in the present case.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

For the reasons above, the request for refund is DISMISSED without prejudice.

Applicant is advised that the declaration filed 05 April 2007 is improper. Specifically, the declaration is an impermissible composite declaration which consists of one of page 1, four of page 2, and two of page 3. Where individual declarations are executed, they must be submitted as individual documents rather than combined into one declaration. Applicant must furnish: (1) a single complete declaration which has been presented to and executed by all of the

inventors or (2) multiple complete declarations, wherein each inventor has executed at least one of the complete declarations.

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 16 April 2007 is hereby VACATED.

The application is being forwarded to the DO/EO/US for processing in accordance with this decision, including preparation and mailing of a Notification of Defective Response (Form PCT/DO/EO/916), which should indicate that the declaration filed 05 April 2007 is defective for the reasons stated above.

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